

Practitioner's Docket No. 2498/101

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Mohammad B. Bahramian, Helmut Zarbl

Application No.: 09/472,558

Group No.: 1632

Filed: 12/27/1999

Examiner: Paras, Jr., P.

For: Muting Gene Activity Using a Transgenic Nucleic Acid

RECEIVED  
JAN 24 2003  
TECH CENTER 1600/2900

**RESPONSE UNDER  
37 C.F.R. § 1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP  
SECOND SUPPLEMENT  
TO RESPONSE E**

Box AF

Commissioner for Patents

Washington, D.C. 20231

AMENDMENT OR RESPONSE AFTER FINAL REJECTION--TRANSMITTAL

1. Transmitted herewith is an amendment after final rejection (37 C.F.R. 1.116) for this application.

**CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\***

(When using Express Mail, the Express Mail label number is *mandatory*;  
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

**MAILING**

[X] deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, Washington D.C. 20231

37 C.F.R. § 1.8(a)

37 C.F.R. § 1.10\*

[X] with sufficient postage as first class mail.

☐ as "Express Mail Post Office to Addressee"

Mailing Label No. \_\_\_\_\_ (mandatory)

**TRANSMISSION**

☐ facsimile transmitted to the Patent and Trademark Office, (703) \_\_\_\_\_

Signature

Date: January 21, 2003

Barbara J. Carter

(type or print name of person certifying)

\* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

## STATUS

2. Applicant is a small entity. A statement was already filed.

## EXTENSION OF TERM

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. 1.136 apply. Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

## FEE FOR CLAIMS

4. The fee for claims (37 C.F.R. 1.16(b)-(d)) has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)	SMALL ENTITY	
	Claims Remaining After Amendment		Highest No Previously Paid For	Present Extra	Rate	Addit Fee
Total	56	Minus	56	= 0	x \$9 =	\$0
Indep	7	Minus	7	= 0	x \$42 =	\$0
First Presentation of Multiple Dependent Claim					+ \$140 =	\$0
Total Addit. Fee						\$0

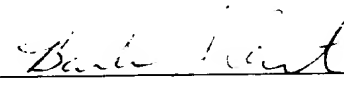
No additional fee for claims is required.

## FEE DEFICIENCY

5. If any additional extension and/or fee is required, charge Account No. 19-4972.

If any additional fee for claims is required, charge Account No. 19-4972.

Date: January 21, 2003

  
Barbara J. Carter  
Registration No. 52,703  
Bromberg & Sunstein LLP  
125 Summer Street  
Boston, MA 02110-1618  
US  
617-443-9292  
Customer No. 02101



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

COPY

EXAMINER
----------

ART UNIT	PAPER
----------	-------

33

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

The reply filed on 12/13/02 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): the sequence listing in computer readable form does not comply with the sequence rules. See the attached raw sequence listing error report. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner(s) should be directed to Peter Paras, Jr., whose telephone number is 703-308-8340. The examiner can normally be reached Monday-Friday from 8:30 to 4:30 (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at 703-305-4051. Papers related to this application may be submitted by facsimile transmission. Papers should be faxed via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers are (703) 308-4242 and (703) 305-3014.

Inquiries of a general nature or relating to the status of the application should be directed to Dianiece Jacobs whose telephone number is (703) 305-3388.

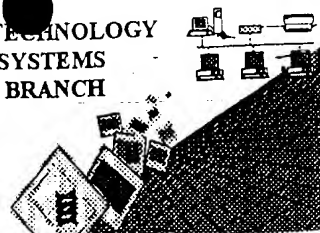
Peter Paras, Jr.  
Art Unit 1632

PETER PARAS  
PATENT EXAMINER

RECEIVED

JAN 24 2003

TECH CENTER 1600/2900



**RAW SEQUENCE LISTING**  
**ERROR REPORT**

The Biotechnology Systems Branch of the Scientific and Technical Information Center (STIC) detected errors when processing the following computer readable form:

Application Serial Number: 09/472,558  
Source: 1600  
Date Processed by STIC: 1/10/02

THE ATTACHED PRINTOUT EXPLAINS DETECTED ERRORS.

PLEASE FORWARD THIS INFORMATION TO THE APPLICANT BY EITHER:

- 1) INCLUDING A COPY OF THIS PRINTOUT IN YOUR NEXT COMMUNICATION TO THE APPLICANT, WITH A NOTICE TO COMPLY or,
- 2) TELEPHONING APPLICANT AND FAXING A COPY OF THIS PRINTOUT, WITH A NOTICE TO COMPLY

FOR CRF SUBMISSION QUESTIONS, PLEASE CONTACT MARK SPENCER, 703-308-4212.

FOR SEQUENCE RULES INTERPRETATION, PLEASE CONTACT ROBERT WAX, 703-308-4216.

PATENTIN 2.1 e-mail help: [patin21help@uspto.gov](mailto:patin21help@uspto.gov) or phone 703-306-4119 (R. Wax)

PATENTIN 3.0 e-mail help: [patin3help@uspto.gov](mailto:patin3help@uspto.gov) or phone 703-306-4119 (R. Wax)

TO REDUCE ERRORED SEQUENCE LISTINGS, PLEASE USE THE **CHECKER**  
**VERSION 3.1 PROGRAM**, ACCESSIBLE THROUGH THE U.S. PATENT AND  
TRADEMARK OFFICE WEBSITE. SEE BELOW FOR ADDRESS:

**<http://www.uspto.gov/web/offices/pac/checker>**

Applicants submitting genetic sequence information electronically on diskette or CD-Rom should be aware that there is a possibility that the disk/CD-Rom may have been affected by treatment given to all incoming mail.

Please consider using alternate methods of submission for the disk/CD-Rom or replacement disk/CD-Rom.

Any reply including a sequence listing in electronic form should NOT be sent to the 20231 zip code address for the United States Patent and Trademark Office, and instead should be sent via the following to the indicated addresses:

1. EFS-Bio (<<http://www.uspto.gov/ebc/efs/downloads/documents.htm>> , EFS Submission User Manual - ePAVE)
2. U.S. Postal Service: U.S. Patent and Trademark Office, Box Sequence, P.O. Box 2327, Arlington, VA 22202
3. Hand Carry directly to:  
U.S. Patent and Trademark Office, Technology Center 1600, Reception Area, 7<sup>th</sup> Floor, Examiner Name,  
Sequence Information, Crystal Mall One, 1911 South Clark Street, Arlington, VA 22202  
Or  
U.S. Patent and Trademark Office, Box Sequence, Customer Window, Lobby, Room 1B03, Crystal Plaza Two,  
2011 South Clark Place, Arlington, VA 22202
4. Federal Express, United Parcel Service, or other delivery service to: U.S. Patent and Trademark Office,  
Box Sequence, Room 1B03-Mailroom, Crystal Plaza Two, 2011 South Clark Place, Arlington, VA 22202

# Raw Sequence Listing Error Summary

1600

## ERROR DETECTED

## SUGGESTED CORRECTION

SERIAL NUMBER: 091472,558

ATTN: NEW RULES CASES: PLEASE DISREGARD ENGLISH "ALPHA" HEADERS, WHICH WERE INSERTED BY PTO SOFTWARE

- 1 ☐ Wrapped Nucleics  
Wrapped Aminos      The number/text at the end of each line "wrapped" down to the next line. This may occur if your file was retrieved in a word processor after creating it. Please adjust your right margin to .3; this will prevent "wrapping."
- 2 ☐ Invalid Line Length      The rules require that a line not exceed 72 characters in length. This includes white spaces.
- 3 ☐ Misaligned Amino  
Numbering      The numbering under each 5<sup>th</sup> amino acid is misaligned. Do not use tab codes between numbers; use space characters, instead.
- 4 ☐ Non-ASCII      The submitted file was not saved in ASCII(DOS) text, as required by the Sequence Rules. Please ensure your subsequent submission is saved in ASCII text.
- 5 ☐ Variable Length      Sequence(s) \_\_\_\_\_ contain n's or Xaa's representing more than one residue. Per Sequence Rules, each n or Xaa can only represent a single residue. Please present the maximum number of each residue having variable length and indicate in the <220>-<223> section that some may be missing.
- 6 ☐ PatentIn 2.0  
"bug"      A "bug" in PatentIn version 2.0 has caused the <220>-<223> section to be missing from amino acid sequences(s) \_\_\_\_\_. Normally, PatentIn would automatically generate this section from the previously coded nucleic acid sequence. Please manually copy the relevant <220>-<223> section to the subsequent amino acid sequence. This applies to the mandatory <220>-<223> sections for Artificial or Unknown sequences.
- 7 ☐ Skipped Sequences  
(OLD RULES)      Sequence(s) \_\_\_\_\_ missing. If intentional, please insert the following lines for each skipped sequence:  
(2) INFORMATION FOR SEQ ID NO:X: (insert SEQ ID NO where "X" is shown)  
(i) SEQUENCE CHARACTERISTICS: (Do not insert any subheadings under this heading)  
(xi) SEQUENCE DESCRIPTION:SEQ ID NO:X: (insert SEQ ID NO where "X" is shown)  
This sequence is intentionally skipped  
  
Please also adjust the "(ii) NUMBER OF SEQUENCES:" response to include the skipped sequences.
- 8 ☐ Skipped Sequences  
(NEW RULES)      Sequence(s) \_\_\_\_\_ missing. If intentional, please insert the following lines for each skipped sequence.  
<210> sequence id number  
<400> sequence id number  
000
- 9 ☐ Use of n's or Xaa's  
(NEW RULES)      Use of n's and/or Xaa's have been detected in the Sequence Listing.  
Per 1.823 of Sequence Rules, use of <220>-<223> is MANDATORY if n's or Xaa's are present.  
In <220> to <223> section, please explain location of n or Xaa, and which residue n or Xaa represents.
- 10 ☒ Invalid <213>  
Response      Per 1.823 of Sequence Rules, the only valid <213> responses are: Unknown, Artificial Sequence, or scientific name (Genus/species). <220>-<223> section is required when <213> response is Unknown or is Artificial Sequence
- 11 ☐ Use of <220>      Sequence(s) \_\_\_\_\_ missing the <220> "Feature" and associated numeric identifiers and responses.  
Use of <220> to <223> is MANDATORY if <213> "Organism" response is "Artificial Sequence" or "Unknown." Please explain source of genetic material in <220> to <223> section.  
(See "Federal Register," 06/01/1998, Vol. 63, No. 104, pp. 29631-32) (Sec. 1.823 of Sequence Rules)
- 12 ☐ PatentIn 2.0  
"bug"      Please do not use "Copy to Disk" function of PatentIn version 2.0. This causes a corrupted file, resulting in missing mandatory numeric identifiers and responses (as indicated on raw sequence listing). Instead, please use "File Manager" or any other manual means to copy file to floppy disk.
- 13 ☐ Misuse of n      n can only be used to represent a single nucleotide in a nucleic acid sequence. N is not used to represent any value not specifically a nucleotide.



1600

Does Not Comply  
Corrective Action Needed

## RAW SEQUENCE LISTING

PATENT APPLICATION: US/09/472,558

DATE: 01/10/2003

TIME: 13:22:07

Input Set : N:\Crf4\01062003\I472558.raw

Output Set: N:\CRF4\01102003\I472558.raw

1 <110> APPLICANT: Bahramian, Mohammad B.  
2 Zarbl, Helmut  
3 <120> TITLE OF INVENTION: MUTING GENE ACTIVITY USING A TRANSGENIC  
4 NUCLEIC ACID  
5 <130> FILE REFERENCE: 2498/101  
6 <140> CURRENT APPLICATION NUMBER: US/09/472,558  
7 <141> CURRENT FILING DATE: 1999-12-27  
8 <160> NUMBER OF SEQ ID NOS: 2  
9 <170> SOFTWARE: FastSEQ for Windows Version 3.0

## ERRORED SEQUENCES

18 <210> SEQ ID NO: 2  
19 <211> LENGTH: 20  
20 <212> TYPE: DNA  
21 <213> ORGANISM: PCR Primer  
22 <400> SEQUENCE: 2  
23 gctgccataa ccatgagtga  
E--> 24 230941 - delete

20

- invalid response, see error summary sheet item 10

→ Please check subsequent sequences for similar errors.

VERIFICATION SUMMARY

PATENT APPLICATION: US/09/472,558

DATE: 01/10/2003

TIME: 13:22:08

Input Set : N:\Crf4\01062003\I472558.raw

Output Set: N:\CRF4\01102003\I472558.raw

L:24 M:254 E: No. of Bases conflict, this line has no nucleotides.